REMARKS

Reconsideration is respectfully requested.

Claims 1 through 5, 7, 8, 10 through 13, 16 through 19, 21, 23, 25 and 27 remain in this application. Claims 6, 9, 14, 15, 20, 22, 24 and 26 have been cancelled. No claims have been withdrawn or added.

Paragraphs 5 through 14 of the Office Action

Claims 1 through 4, 7, 11, 13, 16, 20 (is cancelled), 23, 25 and 27 have been rejected under 35 U.S.C. §102(e) as being anticipated by Talluri.

Claims 1 through 5, 7, 10, 11, 13, 16, 18, 20 (is cancelled), 22, 23 (is cancelled) and 25 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ebstyne in view of Talluri.

Claims 8 and 17 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ebstyne in view of Talluri and further in view of Ebata.

Claims 10 and 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ebstyne in view of Talluri and further in view of Wells.

Claims 12 and 19 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ebstyne in view of Talluri and further in view of Watkins.

Claims 8 and 17 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Talluri in view of Ebata.

Claims 10 and 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Talluri in view of Wells.

Claims 12 and 19 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Talluri in view of Watkins.

Claim 21 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ebstyne in view of Talluri and further in view of Ebata and Watkins.

Claim 1 requires, in part, "receiving by the agent application on the at least one grid computer, from a local user of the at least one grid computer, designation of a minimum amount of disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user". Claims 8, 13, and 21 include similar but not identical requirements.

It is alleged in the rejection of at least claim 1 based upon the Talluri patent application that (emphasis added):

> receiving, by the agent application on the at least one grid computer, from a local user of the at least one grid computer, designation of a minimum amount of disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user (i.e. minimum amount/percentage of unused storage space/capacity to be maintained/reserved on SG or at least one node is inherently defined/designed/set by the user in the storage policy. In other words, the admin/user of the storage system has to initially set the minimum amount/percentage described above in the storage policy);

However, it is submitted that 1) neither the referenced portion nor the rest of the Talluri patent application discloses what entity sets the "storage policy", that 2) the statement quoted above from the rejection concedes that the "storage policy" may be set by an administrator of the Talluri system, and not "a local user of the at least one grid computer" as required by the claims, and that 3) the discussion in the Talluri patent application does not satisfy the requirements of an inherent disclosure as required by the law.

With respect to the first point, the rejection references paragraphs [0015] and [0016] of the Talluri patent application, which state:

> [0015] As such, it is desirable to be able to install a storage policy, where a percentage of the storage capacity (either total storage capacity or unused storage capacity) on a server group (SG) or on a particular node may be shared globally with other resources on the network, on the fly, while a percentage of the same is dedicated solely to that particular server group (SG) or particular node. Such a policy provides an avenue for determining sharable data storage capacity, at any time, in terms of `available/unused or total` capacity rather than just `total` installed capacity and ensures efficient storage capacity utilization by storing data pertaining to a particular node (when data storage capacity for this node has been used) on a collection of other nodes on the network, thereby tapping into the unused data storage capacity and increasing the ROI (return on investment) for the enterprise as a whole.
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> [0016] Another example of a beneficiary of such a storage policy would be an `application services provider` (ASP) where storage requirements and usage rapidly fluctuate. Consider such a company whose primary business is offering managed web-hosting services for their clients, who lease dedicated servers owned and managed by the company (service provider). Beyond a web presence, the clients' websites are further designed to accept customer data and sales orders for their merchandise/services. Such information is stored in databases on the servers. During instances when the data stored on a particular dedicated server is approaching the maximum available capacity (including the capacity on any direct attached storage system that may be connected to and made available to the server) and when the server cannot be taken down (as that would lead to an interruption of business activity)--the ability to seamlessly segment available data storage capacity on other servers (or server groups (SG)) and use a percentage of the same for storing data from this particular server would be a very potent option for the service provider. This may be done temporarily, until additional data storage resources are installed on this particular server or as a policy across all dedicated servers being managed by the service provider.

It is submitted that while these paragraphs discuss a storage policy in general, there is no indication of who sets the "storage policy" that is being discussed. This lack of disclosure appears to be conceded in the Office Action, as the rejection states that "unused storage space/capacity to be maintained/reserved on SG or at least one node *is inherently defined/designed/set* by the user in the storage policy".

As to the second point, the rejection states that "the admin/user of the storage system has to initially set the minimum amount/percentage described above in the storage policy" (emphasis added). Putting aside for the sake of discussion whether this is an accurate characterization of what is discussed in the Talluri patent application, the statement appears to admit that the "storage policy" is set by an administrator that is associated with the storage system of the Talluri system, and not "a local user of the at least one grid computer" as required by the claims. It is submitted that the rejection recognizes that the Talluri document does not disclose the requirements of the claims.

With respect to the third point, the law on establishing that a feature is inherently ("implicitly") present in a document is clear—the Patent Office must "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art". The burden upon the office is more fully set forth in the MPEP at section 2112, where it states (all emphasis in original, case summaries omitted):

> **2112 Requirements of Rejection Based on Inherency; Burden of Proof [R-3] - 2100 Patentability**
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> **IV. EXAMINER MUST PROVIDE RATION-ALE OR EVIDENCE TENDING TO SHOW INHERENCY**
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> The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).
>
> "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably

> support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

It is submitted that the discussion in the discussion in the Talluri patent application does not inherently establish that the storage policy is "receiv[ed] by the agent application on the at least one grid computer, from a local user of the at least one grid computer", as there is not evidence in Talluri that the claimed relationship "necessarily flows from the teaching" as required by the MPEP section 2112 quoted above. As noted previously, the discussion of the storage policy, and how it is set, is vague. Also, the statements in the rejection seem to imply that an administrator of the Talluri system sets the storage policy, and thus it is not set by the "local user of the at least one grid computer". It should be recognized that the language of the claim is very clear as to what qualifies as the local user, and this does not encompass the administrator of the Talluri system over the network system.

For the reasons set forth above, as well as other reasons not set forth, it is submitted that the Talluri patent does not lead one of ordinary skill in the art to the requirement of ""receiving by the agent application on the at least one grid computer, from a local user of the at least one grid computer, designation of a minimum amount of disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user" as set forth in claims 1, 8, 13, and 21.

With respect to the rejections of claims 1, 6, 13, and 21 over the various allegedly obvious combinations of the Ebstyne patent application, the rejection states:

> receiving, by the agent application on the at least one grid computer, from a local user of the at least one grid computer, designation of a minimum amount of disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user (Ebstyne discloses, in paragraph [0077], "[T]he client tier 46 serves

> several functions, such as *reserving a configurable portion of available storage space* and reacting dynamically to the changing local environment.", i.e. the admin/user can configure/designate the portion of available space to be reserved);

Looking to the referenced portion of the Ebstyne patent application at paragraph [0077], it states:

> [0077] The client tier 46 exists in all of the plurality of enterprise personal computers 32 that are going to be used to recapture the unused disk space and brokers unused disk space by intelligently managing blocks of data sent to and from the service tier 42. The client tier 46 serves several functions, such as reserving a configurable portion of available storage space and reacting dynamically to the changing local environment. As local disk-space is used by local applications, the client tier 46 will relinquish the reserved storage space. As local storage space becomes free, the client tier 46 gradually assumes more of the storage space. For example, if the service tier 42 needs to write a certain amount of data, the client tier 46 determines the best one of the plurality of enterprise personal computers 32 for this particular amount of data to be stored based on its usage requirements.

Initially, it is noted that 1) the discussion in Ebstyne (and particularly paragraph [0077]) is not clear as to who controls the "client tier" on the "enterprise personal computer", that 2) the discussion in Ebstyne is directed to reserving storage space for the enterprise storage system of Ebstyne, and not "a minimum amount of disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user" as required by the language of claim 1.

With respect to the first point, the discussion in the Ebstyne patent application does not discuss, and is not clear regarding, what entity controls the "client tier" on the enterprise personal computer. Claim 1 et al. requires that the designation come from "a local user of the at least one grid computer", and the Ebstyne patent application does not disclose this. One can speculate what entity reserves the configurable portion in Ebstyne, but that speculation is not sufficient to support a rejection. Merely because the client tier may reside on the enterprise personal computer does not disclose

to one of ordinary skill in the art that a user of the enterprise personal computer is able to "reserve a configurable portion" of the disk space for the enterprise storage resource management system of Ebstyne. In fact, it is submitted that it would be counterintuitive for a user of the enterprise personal computer to be able to set the operation parameters of the enterprise storage resource management system.

With respect to the second point above, the Ebstyne patent application refers to reserving a portion of the disk drive of the enterprise personal computer for use by the enterprise storage resource management system, and not for "disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user" as required by the claims. It is submitted that the local user is primarily concerned with the reservation of space for the local user's purposes.

It is therefore submitted that the cited patents, and especially the various allegedly obvious combinations of Ebstyne, Talluri, Ebata, Wells, and Watkins, set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 7, 8, 13, 21 and 25. Further, claims 2, 4, 5, 10 and 11, which depend from claim 1, claim 3, which depends from claim 2, claim 12, which depends from claim 4, claims 16 through 19 which depend from claim 13 and claim 23, which depends from claim 3 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §102(b) and §103(a) rejections of claims 1 through 5, 7, 8, 10 through 13, 16 through 19, 21, 23, 25 and 27 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.

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Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. **40,158**
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357